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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PHAM, HAI CHI

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,676

Applicant(s)

BRONSON, BARRY

Examiner

Hai C Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 15 and 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 . 6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claims 7 and 12 are objected to because of the following informalities:

Claim 7:

- Line 9, "said symbol set controls" should read –said symbol set is used to control–.

Claim 12:

- Lines 10-11, "said symbol set ... controls" should read –said symbol set ... is used to control–.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1:

- "said *disk* drive" lacks antecedent basis.

Claim 6:

- Claim 6 recites a label printer writing device for “thermally write to said thermally-sensitive layer”, the label printer writing device being distinct from the laser head, which is used as a read and writing laser head. Such limitation appears to be in conflict with the recitation of the parent claim 1, which indicates that the laser head itself is performing the label printing by thermally writing the symbol set to the thermally sensitive layer of the disk storage medium.

Claims 2-5 are dependent from claim 1 above, and are therefore indefinite.

Appropriated correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 7, 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Honda et al. (Pub. No. U.S. 2002/0191517 A1).

Honda et al. discloses a method and apparatus for printing label on an optical disk, which comprises a disk storage medium (optical disk 10) including a thermally-sensitive layer (heat-sensitive layer 18) (paragraph [0030]) formed on at least a portion of an upper surface of said disk storage medium (Fig. 1), a rotational drive

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(spindle motor/spindle servo) for rotating said disk storage medium, a transverse drive including a laser head (laser diode of the optical pick-up 66 transversely moved by the feed motor 72) for moving a laser of said disk drive substantially transversely with respect to said disk storage medium. Honda et al. teaches the symbol set (graphic image or character as well as the label printer driver (coordinates of the label to be printed on the optical disk with respect to that of the optical disk) (paragraph [0038]) being stored in and provided by an external device, e.g., host computer, and a processor (system control 62) communicating with the external device, the rotational drive, the transverse drive, and the laser, and wherein the processor uses the label printer driver (coordinates of the label with respect to the coordinate reference of the optical disk as instructed on the basis of the image data) (paragraph [0047]) to control said rotational drive and the transverse drive in order to thermally write the symbol set to the thermally-sensitive layer of the disk storage medium using the laser.

With regard to claims 2-4, Honda et al. teaches the image data of the label including information of the coordinates of the label printing area with respect to coordinates of the optical disk such that the translation drive of the optical pickup and the spindle motor can be controlled during the label printing.

With regard to claim 5, Honda et al. teaches the laser head comprising a read laser and a writing laser (enclosed in the optical pickup 66) positioned below said disk storage medium, with said writing laser being used to thermally write to said thermally-sensitive layer (18).

With regard to claim 10, Honda et al. teaches rotating the optical disk (via spindle motor), transversely moving the optical pickup containing the laser (via feed motor), tracking a transverse position of the laser (via tracking servo (78) during the label printing by the laser.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 8, 9, 11-14, 16-17, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al. in view of Kahle (U.S. 6,074,031).

With regard to claim 12, Honda et al. discloses the method of label printing including the steps of loading a symbol set (loading label information as graphic image or character from a host computer) to a processor (system control 62) controlling a disk drive (Fig. 6), with said symbol set including one or more predetermined symbols or graphics to be written to said disk storage medium (10), heating with a laser (within the optical pickup 66) a thermally-sensitive layer (heat-sensitive layer 18) formed on at least a portion of an upper surface of said disk storage medium (Fig. 1), and manipulating said laser with respect to said disk storage medium (based on the label image information).

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However, Honda et al. fails to teach the alignment mark for aligning complete label, the alignment mark being pre-printed. Although Honda et al. suggests that the label printer can be provided as a stand-alone system from the regular read/write system of the CD recorder, Honda et al. fails to teach the separate label printer being positioned above the optical disk while the read/write laser head is disposed below the optical disk.

Kahle, an acknowledged prior art, discloses a method and apparatus for printing labels on digital recording media, the apparatus includes an independent label printer (12) positioned above the optical disk, separate from the read/write laser head disposed on the other side of the disk (col. 4, lines 45-65). Kahle further teaches the provision of the pre-printed orientation mark (24) on the surface of the disk for use in sensing the speed of the disk during the label printing process as well as for indicating a reference position or orientation of the disk for aligning the label printing area.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Honda et al. with the aforementioned teachings of Kahle. The motivation for doing so would have been to provide means for accurately locating the label printing area on the surface of the disk while in rotation.

With regard to claim 19, Honda et al. further teaches the laser comprising a writing laser (the laser being used for both label writing and data recording) positioned below said disk storage medium, and further comprising the preliminary step of detecting an orientation of said disk storage medium (detecting the orientation mark 24),

and wherein the heating step is performed by said writing laser and the loading, heating, and manipulating steps are performed if said disk storage medium is inverted.

(paragraph [0040]).

With respect to claim 21, Honda et al. further teaches the steps of rotating said disk storage medium, transversely moving said laser with respect to said disk storage medium, tracking a rotational position of said disk storage medium in a rotational position variable, and tracking a transverse position of said laser in a transverse position variable, wherein said rotational position and said transverse position are used by said processor for manipulating said laser with respect to said disk storage medium (Fig. 6).

Allowable Subject Matter

8. Claims 15 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: the primary reason for the indication of the allowability of the claimed invention, with respect to claim 15, is the inclusion of the limitation, in the combination as currently claimed, that the one or more alignment marks were previously written to a data contents of the disk storage medium, and which is not found taught or fairly suggested by the prior arts made of record, considered alone or in combination.

The primary reason for the indication of the allowability of the claimed invention, with respect to claim 18, is the inclusion of the limitation, in the combination as currently

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claimed, that the ejection of the disk storage medium being performed according to a predetermined orientation using digital data stored on the disk storage medium, and which is not found taught or fairly suggested by the prior arts made of record, considered alone or in combination.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (703) 308-1281. The examiner can normally be reached on T-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin R. Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, (703) 305-3432 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



HAI PHAM
PRIMARY EXAMINER
May 3, 2003